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09/484,098

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19-3

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EXAMINER

TODD, GREGORY G

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**Technology Center 2100**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/484,098  
Filing Date: January 18, 2000  
Appellant(s): BAKER ET AL.

\_\_\_\_\_  
Joseph B. Ryan  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 28 June 2007 appealing from the Office action mailed 19 December 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

Claims 1-21, rejected under 35 USC 101 as being directed to non-statutory subject matter.

Claims 1-21, rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential elements.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,088,725	Kondo et al	07-2000
6,493,348	Gelman et al	12-2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-13, and 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kondo et al (hereinafter "Kondo", 6,088,725).

As per Claims 1, 11 and 21, Kondo teaches an apparatus, a method, and a machine-readable medium storing one or more programs for use in interfacing a local network to one or more external network elements, wherein Kondo teaches:

a gateway coupled between the local network and the one or more external network elements, the gateway being operative to determine remotely-assigned

Art Unit: 2157

address information for a given device attached to the local network (at least col. 9, lines 15-40; assignment of present address); and to establish, based at least in part on the remotely-assigned address information, a substitution address for use by at least one other device attached to the local network when communicating with the given device (at least col. 9, lines 15-40; col. 10, lines 5-52; using address conversion processing via extracted address information).

As per Claims 2 and 12.

the remotely-assigned address information comprises an Internet protocol (IP) address assigned to the at least one device by an external network element (at least col. 5, lines 15-33).

As per Claims 3 and 13.

the local network comprises a local area network (LAN) (at least 5, lines 1-33).

As per Claims 5 and 15.

the gateway stores remotely-assigned address information for each of a plurality of devices attached to the local network (at least col. 7, lines 1-39; table storing).

As per Claims 6 and 16.

the gateway stores a set of address information for each of the plurality of devices, the set of address information for a given one of the devices comprising an address to be used by the given device in communicating with the gateway, and addresses to be used by the given device in communicating with each of the other devices (at least col. 7, lines 1-39; Fig. 1; eg. each PC101).

As per Claims 7 and 17.

the stored information comprises an address substitution matrix having a row of address information for each of the plurality of devices attached to the local network (at least col. 7, lines 1-39; correspondence table).

As per Claims 8 and 18.

a given one of the sets of address substitution information for a particular one of the plurality of devices comprises a set of IP addresses, each of which is sub-network compatible with an IP address remotely assigned to the corresponding device, such that communications between the given device and another one of the devices attached to the local network are not routed through an external network element (at least col. 5, lines 15-33; routing control for which network to be relayed).

As per Claims 9 and 19.

the gateway processes a particular received packet in order to replace remotely-assigned address information in a header thereof with a corresponding substitution address determined by the gateway (at least col. 7, lines 40-67; address replacing).

As per Claims 10 and 20.

the gateway intercepts at least one of control information and maintenance information received over the local network and associated with the given device so as to perform related services on behalf of the given device (at least col. 5, lines 15-61; control).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konda in view of Gelman et al (hereinafter "Gelman", 6,493,348).

Kondo does explicitly disclose the gateway comprising an ADSL termination unit-receive device (ADSL modem). However, the use and advantages for using such a modem is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Gelman (at least Gelman col. 6, lines 5-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of specifically an ADSL modem into Kondo's system because this would simply expand the compatibility of Kondo's system and network transit devices such as a router (at least col. 4, lines 10-20) with future systems and networks such as xDSL / ADSL networks and ATU-R's. Additionally, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill at the time of the invention.

**(10) Response to Argument**

Appellant's arguments filed 28 June 2007 have been fully considered but they are not persuasive.

Appellant argues Kondo fails to teach the gateway/address mapping server (AMS) being coupled between the local network and the one or more external network elements as recited in claim 1. However, Kondo teaches an AMS (Fig. 1, 11; 102) being coupled between the LAN (105) and the Internet (106) via an external network *element* (router, 103). It is important to note that the claims state the address information determining gateway/AMS being coupled 'between the local network and the one or more external network *elements*' (emphasis shown). Contrary to being coupled between, for example, a local network and one or more external *networks*, the AMS of Kondo is being coupled between a local network and a router, wherein the router is an external network element as it is connected to an external network (Internet 106). Kondo teaches the router/ external network element performing routing control to decide which network a data packet is to be relayed (at least col. 5:7-33). Kondo goes on to say that the routers separate the LAN 105a and 105b networks. As such the router cannot be an internal network element, and must be an external network element connecting external networks together.

Further, such use of the term "between" as used in the specification, is not used as a physical separation among objects/devices/networks, but rather is merely used as "ensur[ing] that communications between registered devices on the LAN 102..." (current



specification p. 7:19-21) and "subsequent communication between devices on the local network" (p. 2:19-20). Therefore, Kondo teaches the limitations of claim 1, 11, and 21.

Appellant also argues Kondo fails to teach the particular type of stored information recited in claims 6, 7, 16, and 17. However, Kondo clearly teaches this as Kondo teaches the AMS having a correspondence table relating home address information with present address information (at least col. 7:1-39), and within the table would be stored address information for PC 101, for example, to use corresponding addresses when communicating with the AMS.

Appellant further argues Kondo does not teach the limitations recited in claims 8 and 18. However, Kondo teaches a PC 101 being given a present address and the router controlling the routing based on said address being given to PC 101 (at least col. 5:15-33), thus if the PC 101 were to only communicate within the local LAN, it would be given a present address for such and the router would route the packet back onto the same local LAN.

Appellant additionally argues Kondo does not teach the limitations recited in claims 10 and 20. However, Kondo clearly teaches intercepting at least one of- control information, as Kondo teaches the AMS mapping IP addresses (at least col. 7:1-39) for connected devices on a network and such address information is used to perform related services on behalf of the connected devices as the router then utilizes such address information for routing control (at least col. 5:15-33) of packets from the devices.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill at the time of the invention. As Gelman teaches using an ATU-R device, as Appellant admits, and Kondo teaches the functionality of claims 1 and 11, it would have been obvious to one of ordinary skill at the time the invention was made to incorporate the ATU-R device of Gelman into Kondo's AMS as this would have yielded predictable results.


**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2157

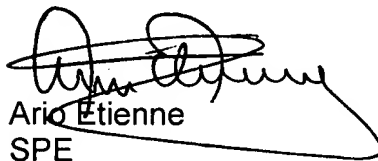
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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